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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,836	09/29/2000	CHRISTOPHER T COTTON	21295/100	1389

7590 04/02/2003

Brown, Rudnick, Freed & Gesmer
One Financial Center
Boston, MA 02111

EXAMINER

NGUYEN, MICHELLE P

ART UNIT	PAPER NUMBER
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2851

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s) N .

09/676,836

Applicant(s)

COTTON ET AL.

Examiner

Michelle Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

2. The disclosure is objected to because of the following informalities:
- (a) It lacks a descriptive discussion about Fig. 9.
 - (b) On page 17, lines 11-12, "Figs. 14E and 14F" should be --Figs. 13E and 13F--.

Appropriate correction is required.

Claim Objections

3. Claims 2-12, 15 and 17 are objected to because of the following informalities:
- (a) In claim 2, line 2, "and" should be --or--.
 - (b) In claim 3, line 3, "the second path" should be --the second prism--.
 - (c) Claim 4 recites the limitation "the frame" in line 2. There is insufficient antecedent basis for this limitation in the claim.
 - (d) In claim 5, line 2, "and" should be --or--.
 - (e) In claim 6, line 12, "engaged" should be --engaged with--.

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- (f) Claim 7 recites the limitation "the frame" in line 2. There is insufficient antecedent basis for this limitation in the claim.
- (g) In claim 8, line 2, "and" should be --or--.
- (h) In claim 9, line 2, "and" should be --or--.
- (i) In claim 10, line 2, "critical angle prism" should be --a critical angle prism--.
- (j) In claim 11, line 2, "and" should be --or--.
- (k) In claim 12, line 2, "critical angle prism" should be --a critical angle prism--.
- (l) In claim 15, line 1, "Claim 15" should be --claim 14--.
- (m) In claim 15, line 2, "and" should be --or--.
- (n) In claim 17, line 2, "and" should be --or--.

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 3, 4, 10 and 14 of the instant application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable

over claims 1 and 14, 2, 21, 23 and 27, respectively, of U.S. Patent No. 5,969,808.

Although the conflicting claims are not identical, they are not patentably distinct from each other.

With regard to claim 1 of the instant application, the refractometric apparatus for use with fluids is met by the refractometric apparatus for use with a hydraulic fluid set forth in claim 1 of U.S. Patent No. 5,969,808 because a hydraulic fluid is a fluid.

Claim 1 of the instant application recites means for defining an optical path, a reticle, a prism and temperature sensitive means. Each of these limitations is met by the means for defining an optical path, the reticle, the prism, and the temperature sensitive means, respectively, set forth in claim 1 of U.S. Patent No. 5,969,808.

Claim 1 of the instant application further recites a second prism. Claim 1 of U.S. Patent No. 5,969,808 further recites a reflecting element. It is well known in the art to employ a prism as a reflecting element. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute for one well-known reflecting element another well-known reflecting element.

With regard to claim 3 of the instant application, the focusing means is met by the focusing means set forth in claim 2 of U.S. Patent No. 5,969,808.

With regard to claim 1 of the instant application, the refractometric apparatus for use with fluids is met by the refractometric apparatus for use with a hydraulic fluid set forth in claim 14 of U.S. Patent No. 5,969,808 because a hydraulic fluid is a fluid.

Claim 1 of the instant application recites means for defining an optical path, a reticle, a prism and temperature sensitive means. Each of these limitations is met by

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the means for defining an optical path, the reticle, the prism, and the temperature sensitive means, respectively, set forth in claim 14 of U.S. Patent No. 5,969,808.

Claim 1 of the instant application further recites a second prism. Claim 14 of U.S. Patent No. 5,969,808 further recites a second prism having a face covered by a reflective coating. It is well known in the art to provide on a face of a prism a reflective coating for maximizing light conducted through the prism. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide on a face of the second prism set forth in the instant application a reflective coating for maximizing light conducted through the prism.

With regard to claim 4 of the instant application, the temperature sensitive means is met by the temperature sensitive means set forth in claim 21 of U.S. Patent No. 5,969,808.

With regard to claim 10 of the instant application, the method for measuring water content in a fluid for use with an apparatus is met by the method for measuring water content in a hydraulic fluid for use with an apparatus set forth in claim 23 of U.S. Patent No. 5,969,808 because a hydraulic fluid is a fluid.

Claim 10 of the instant application recites placing, allowing, compensating and observing steps. Each of these steps is met by the placing, allowing, compensating and observing steps, respectively, set forth in claim 23 of U.S. Patent No. 5,969,808.

With regard to claim 14 of the instant application, the method of measuring water content in a fluid for use with an apparatus is met by the method of measuring water

content in a hydraulic fluid for use with an apparatus set forth in claim 27 of U.S. Patent No. 5,969,808 because a hydraulic fluid is a fluid.

Claim 14 of the instant application recites placing, allowing and adjusting steps. Each of these steps is met by the placing, allowing and adjusting steps, respectively, set forth in claim 27 of U.S. Patent No. 5,969,808.

6. Claims 2, 5, 11 and 15 of the instant application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 5,969,808 as applied to claims 1, 4, 10 and 14 of the instant application above, respectively, and further in view of applicant's admitted prior art (AAPA).

The claims of U.S. Patent No. 5,969,808 do not recite a refractometric apparatus for use with sugar solutions, juices, salt solutions, antifreeze or lubricants. However, AAPA teaches that it is well known in the art to employ refractometers for use with such fluids (see specification, page 2, lines 6-12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a fluid that best suits the purpose for using the refractometric apparatus set forth in the instant application.

7. Claims 6, 7, 12 and 16 of the instant application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 16, 5 and 6, respectively, of U.S. Patent No. 6,034,762. Although the conflicting claims are not identical, they are not patentably distinct from each other.

With regard to claim 6 of the instant application, the refractometric apparatus for use with a fluid is met by the refractometric apparatus for use with hydraulic fluids set forth in claim 3 of U.S. Patent No. 6,034,762 because a hydraulic fluid is a fluid.

Claim 6 of the instant application recites means for defining an optical path, an array of photosensitive elements, a prism and temperature sensitive means. Each of these limitations is met by the means for defining an optical path, the array of photosensitive elements, the prism, and the temperature sensitive means, respectively, set forth in claim 3 of U.S. Patent No. 6,034,762.

Claim 6 of the instant application further recites a second prism. Claim 3 of U.S. Patent No. 6,034,762 further recites a second prism having a face covered by a reflective coating. It is well known in the art to provide on a face of a prism a reflective coating for maximizing light conducted through the prism. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide on a face of the second prism set forth in the instant application a reflective coating for maximizing light conducted through the prism.

With regard to claim 7 of the instant application, the temperature sensitive means is met by the temperature sensitive means set forth in claim 16 of U.S. Patent No. 6,034,762.

With regard to claim 12 of the instant application, the method for measuring water content in a fluid for use with an apparatus is met by the method for measuring water content in a hydraulic fluid for use with an apparatus set forth in claim 5 of U.S. Patent No. 6,034,762 because a hydraulic fluid is a fluid.

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Claim 12 of the instant application recites placing, allowing, compensating and observing steps. Each of these steps is met by the placing, allowing, compensating and observing steps, respectively, set forth in claim 5 of U.S. Patent No. 6,034,762.

With regard to claim 16 of the instant application, the method of measuring water content in a fluid for use with an apparatus is met by the method of measuring water content in a hydraulic fluid for use with an apparatus set forth in claim 6 of U.S. Patent No. 6,034,762 because a hydraulic fluid is a fluid.

Claim 16 of the instant application recites placing, allowing and adjusting steps. Each of these steps is met by the placing, allowing and adjusting steps, respectively, set forth in claim 6 of U.S. Patent No. 6,034,762.

8. Claims 8, 9, 13 and 17 of the instant application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,034,762 as applied to claims 7, 6, 12 and 16 of the instant application above, respectively, and further in view of applicant's admitted prior art (AAPA).

The claims of U.S. Patent No. 6,034,762 do not recite a refractometric apparatus for use with sugar solutions, juices, salt solutions, antifreeze or lubricants. However, AAPA teaches that it is well known in the art to employ refractometers for use with such fluids (see specification, page 2, lines 6-12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a fluid that best suits the purpose for using the refractometric apparatus set forth in the instant application.

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Conclusion

9. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,355,211 to Thompson et al.

U.S. Patent No. 5,243,321 to Iwata

U.S. Patent No. 4,451,147 to Dobes et al.


U.S. Patent No. 3,329,060 to Holleran

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Nguyen whose telephone number is 703-305-2771. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on 703-308-2847. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4900.

mpn
March 27, 2003


RUSSELL ADAMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800